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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,660	12/11/2003	John L. Nealon	P-4628-3-C1-D1	3507

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EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,660

Applicant(s)

NEALON ET AL.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7-26-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nesbitt (4,431,193). Regarding claim 31, Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer may be made from an ionomer such as Surlyn 1605, which has a Shore D hardness of 62. The inner cover layer has a thickness from 0.02 to 0.07 inch. The outer cover layer may be made from Surlyn 1855, which has a Shore D hardness of 55. The outer cover layer has a thickness from 0.02 to 0.10 inch. Regarding claim 33, Surlyn 1605 is a low acid ionomer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,431,193). Regarding claims 20 and 21, Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer may be made from an ionomer such as Surlyn 1605, which has a Shore D hardness of 62. The outer cover layer may be made from Surlyn 1855, which has a Shore D hardness of 55. Nesbitt does not disclose the spin factor. However since the materials fall within applicant's range the properties will also be within applicant's range. Regarding claim 22, the outer cover layer has a thickness from 0.02 to 0.10 inch. Regarding claim 23, the inner cover layer has a thickness from 0.02 to 0.07 inch. Regarding claim 24, Surlyn 1605 is a low acid ionomer. Regarding claim 25, the outer cover layer is made from a soft, low flexural modulus resinous material (fig 2). Regarding claim 26, the inner cover layer is made from a hard, high flexural modulus resinous material (fig 2). Regarding claim 27, Nesbitt does not disclose the PGA compression or COR for the golf ball. However since the materials fall within applicant's range the properties will also be within applicant's range.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,431,193) in view of Saito (4,919,434). Nesbitt discloses the invention as shown above but does not disclose a dual core. However, Saito teaches a golf ball comprising a single or dual core and dual cover. One skilled in the art would have modified the core layers for the desired properties. The modification is also a design choice.

Claims 28, 29, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,431,193) in view of Sullivan (4,884,814). Nesbitt discloses

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the invention as shown above but does not disclose the outer cover comprising a blend of ionomers. However, Sullivan teaches a cover composition comprising hard and soft low acid ionomers. One skilled in the art would have modified the cover material for enhanced resiliency.

Claims 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,431,193) in view of Cavallero (5,688,191). Nesbitt discloses the invention as shown above but does not disclose the cover layers made from polyurethane. However, Cavaellero teaches a dual cover made from polyurethane. One skilled in the art would have modified the cover materials to obtain a softer cover (feel).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No.

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6,213,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '894 patent claim golf balls comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer has a Shore D hardness of at least 60 measured on the curved surface and is made from polyphenylene ether/ionomer blends, ionomers, polyamides, polyurethanes, polyester elastomers, polyester amides, metallocene catalyzed polyolefins, and blends thereof. The outer cover layer has a Shore D hardness of no more than 55 as measured on the curved surface and is made from ionomer and polyurethanes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rg
December 23, 2004



RAEANN GORDEN
PRIMARY EXAMINER